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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,365	09/27/2001	Kazuo Kondo	0425-0854P	9474
2292	7590	07/19/2002		
BIRCH STEWART KOLASCH & BIRCH			EXAMINER	
PO BOX 747			NGUYEN, HELEN	
FALLS CHURCH, VA 22040-0747				
		ART UNIT	PAPER NUMBER	
		1617		

DATE MAILED: 07/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicant No.</b>	<b>Applicant(s)</b>
	09/963,365	KONDO ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Helen Nguyen	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 June 2002.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

The amendment and election of paper no. 5 and 8, filed February 25, 2002 and June 3, 2002 respectively, are acknowledged. All arguments are fully considered.

Applicant's election with traverse of Group I, claims 1-3 and 18-19. In addition, Applicants elected species A of claims 1-3, in Paper No. 8 is acknowledged. The traversal is on the ground(s) that a search of both composition (Group III) and method (Group I) claims should examine together and would not place an additional burden on the examiner. This is not found persuasive because the record set forth in the previous restriction requirement clearly indicates that the delineated inventions are, in fact, patentably distinct, each from the other, and their different classification would necessitate additional searching.

The requirement is still deemed proper and is therefore made FINAL.

In addition, Applicants willing election of the species 2, 7, 8-trimethyl-2-( $\beta$ -carboxyethyl)-6-hydroxychromane ( $\gamma$  CEHC) is acknowledged.

Claims 4-7 are canceled.

Claims 1-3 and 8-19 are pending.

Claims 8-19 are non-elected.

Claims 1-3 are presented for examination.

***Priority***

The claimed priority of this application to Japan Application No. 2000-294802, filed on September 27, 2000, is acknowledged.

***Claim rejection- 35 USC § 112***

The rejection of record set forth in previous Office Action, paper no. 4, under 35 U.S.C. 112, second paragraph, is made moot due to cancelation of claims 4-7.

***Claim rejection- 35 USC § 102 and 103***

The rejections of record set forth in previous Office Action, paper no. 4, under 35 U.S.C. 102 and 103 are made moot.

***New specification objection***

The disclosure is objected to because of the following informalities: On page 5, line 3, the term "etc." is vague because it is non-limiting. "and the like" is suggested.

Appropriate correction is required.

- ❖ The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants'

cooperation is requested in correcting any errors of which applicants may become aware in the specification.

***New Claim rejection- 35 USC § 112***

- ❖ The following is a quotation of the **first paragraph of 35 U.S.C. 112**:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for arteriosclerosis, does not reasonably provide enablement for diseases other than arteriosclerosis. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. On page 3, line 1 of the specification, Applicants only disclose arteriosclerosis. No other diseases are specified.

- ❖ The following is a quotation of the **second paragraph of 35 U.S.C. 112**:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the term “preventing” is vague. It is unclear as to what criteria are used to determine “prevention”. It’s a subjective term.

In claim 1, lines 3-4, the phrase “at least one” is improper Markush Language. Only one member of a Markush group should be elected. “and mixture thereof” is suggested as the last member of the group.

### ***New claim rejection- 35 USC § 101***

❖ 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3 are rejected under **35 U.S.C. 101** because the claimed invention lacks patentable utility. Applicants provide no evidence of prevention. Further, such evidence cannot be demonstrated simply because symptoms can arise at any time beyond any experimental period of observation designated by Applicants.

### ***Conclusion***

Claims 1-3 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Nguyen whose telephone number is (703) 605-1198. The examiner can normally be reached on M-F (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Edward J. Webman can be reached at (703) 308-4432 or her supervisor, Minna Moezie can be reached at (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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Helen Nguyen  
Patent Examiner

July 18, 2002



EDWARD J. WEBMAN  
PRIMARY EXAMINER  
GROUP 1560